

Remarks

The Applicants proceed with the understanding that a failure to respond to the alleged defects of the present reissue application will NOT result in the surrender of the original patent (6,224,216 ('216)). See Appendix A on page 3 of this paper. Accordingly, the Applicants hereby express their intent to not file the supplemental reissue oath/declaration under 37 C.F.R. § 1.175(b)(1) in a Response to the Office Action at the present time.


Notwithstanding the foregoing, if the '216 patent was surrendered, applicants hereby request return of the '216 patent in accordance with 37 C.F.R. § 178(a) (if "a reissue application is refused, the original patent, if surrendered, will be returned to the applicant upon request."). If the Examiner has any questions, he is invited to contact the undersigned at (503) 796-2972.

It is the Applicants' belief that because this communication is non-responsive to the Office Action, there are no extension fees due with this communication. However, if it is determined that extension fees are due, the Commissioner is hereby authorized to charge shortages to Deposit Account No. 500393.

Respectfully submitted,

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Appendix A: Legal Analysis

The reissue statute provides that the original patent is not surrendered until the reissue application issues. 35 U.S.C. § 251 (Director is granted with the power to reissue a patent "on the surrender" of such patent). See also 35 U.S.C. § 252 ("The surrender of the original patent shall take effect upon the issue of the reissued patent . . ."). In addition, according to *In re Clement*, the original claims of the issued patent ('216) continue to exist unaffected by the examiner's rejection of claims 1-10 in the reissue application. *In re Clement*, 131 F.3d 1464, 1472 (Fed. Cir. 1997) (original claims of a patent continue to exist, with their normal presumption of validity, regardless of whether an examiner has rejected the claims in a reissue application based on an alleged defective declaration). Further, the examination statute provides that it is the application that becomes abandoned for failure to reply to an office action, not the original patent. 35 U.S.C. § 133 (application becomes abandoned upon "failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant."). Therefore, if a response to the office action is not received, the reissue application will never issue; ensuring that the original patent is not surrendered. Accordingly, a failure to file a response to the office action will not result in the forfeiture of the original patent.